

Appl. No.: 10/664,483
Amdt. dated May 28, 2008
Reply to Office Action of November 28, 2007

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed November 28, 2007. In that Office Action, Claims 1-9, 17, 19-25, 27, and 29-30 were rejected under 35 U.S.C. § 103(a) as obvious in light of U.S. Published Patent Application 2002/0165741 to Becker et al. (“*Becker*”), and in view of U.S. Published Patent Application 2002/0010599 to Levison (“*Levison*”). In addition, Claim 26 was rejected under 35 U.S.C. § 103(a) as obvious in light of *Becker* in view of *Levison* and further in view of U.S. Patent 6,519,470 to Rydbeck (“*Rydbeck*”). The rejections are addressed below. For the Examiner’s reference, Applicants have previously cancelled Claims 18 and 28, previously withdrawn Claims 10-16, currently amended Claims 1 and 17, currently cancelled Claims 9 and 30, and added new Claims 31-33. Following the amendments, Claims 1-8, 17, 19-27, 29, and 31-33 remain pending in the application.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected Claims 1-9, 17, 19-25, 27, and 29-30 under 35 U.S.C. § 103(a) as obvious in light of U.S. Published Patent Application 2002/0165741 to Becker et al. (“*Becker*”), and in view of U.S. Published Patent Application 2002/0010599 to Levison (“*Levison*”). In addition, Claim 26 was rejected under 35 U.S.C. § 103(a) as obvious in light of *Becker* in view of *Levison* and in further view of U.S. Patent 6,519,470 to Rydbeck (“*Rydbeck*”). The rejection of each claim is addressed below.

Independent Claim 1

The Examiner has rejected independent Claim 1 under 35 U.S.C. § 103(a) as obvious in light of *Becker*, in view of *Levison*. Although Applicants do not agree with the current rejection of Claim 1, in order to facilitate prosecution of the present application, Applicants have amended Claim 1 to further distinguish the claimed invention from the cited prior art. For example, Applicants have amended Claim 1 to specify “*said service contract is provided by a first provider and said insurance coverage is provided by a second provider, said first and second providers being different entities.*” Emphasis added.

Applicants note that *Becker* describes a method for providing registration services and loss protection services related to marked jewelry. *See Abstract.* In particular, the method provides the bundling of registration and loss protection services that do not interfere with normal jewelry trade business practices. *See ¶ [0008].* This is accomplished by a facilitator (e.g., a wholesaler, sightholder, dealer, or retailer) bundling both a database registration service and a loss protection service at or before or just after a transfer of ownership of the jewelry takes place. *Id.*

A facilitator obtains a quantity of jewelry items (e.g., a lot) and enters into an agreement with an insurer and/or commercial database which enables the insurer to provide immediate loss protection services to the consumer who purchases the jewelry at or after the point of purchase. *See ¶ [0015].* In addition, data pertaining to the lot items are entered into the database for use in identifying, insuring, and tracking the jewelry. *Id.*

When a consumer purchases a jewelry item, the ownership information in regard to the item is updated in the database. *See ¶ [0017].* Upon loss of an item, the database is further updated and the entry of the loss may include “lost,” “stolen,” and/or “destroyed” indicators. *Id.* Lastly, an evaluation is carried out to determine the extent of the loss and a subsequent repair, replacement, or cash settlement is provided under the terms of the insurance. *Id.*

On Page 5 of the Office Action, the Examiner asserts that *Becker* discloses in paragraph [0018] the feature wherein the service contract and insurance coverage recited in Claim 1 are provided by different entities. (Note that the Examiner presented this argument in regard to dependent Claim 9.) However, Applicants respectfully disagree. Paragraph [0018] of *Becker* discusses the bundling of the registration and loss protection services at the sightholder, dealer, or retailer level. Furthermore, with respect to a retailer, paragraph [0018] discusses that in one embodiment the retailer would be an insurance specialist or have a contractual relationship with a commercial database and/or insurer who provides the bundled registration and insurance protection services. Thus, paragraph [0018] of *Becker* is concerned with the retailer either providing the bundled services it self or contracting to have

a second party provide the bundled services. Paragraph [0018] is not concerned with providing a service contract and insurance coverage from two different entities.

Thus, paragraph [0018] of *Becker* fails to disclose or suggest “selling … a service contract” and “providing … insurance coverage” to a customer, wherein “said service contract is provided by a first provider and said insurance coverage is provided by a second provider, ***said first and second providers being different entities.***” Emphasis added.

In addition, *Levison* fails to overcome the deficiencies of *Becker*. *Levison* describes a method that involves awarding a special currency (coverage credits) that can be used to acquire additional insurance coverage amounts in return for a consumer taking agreed upon actions. *See ¶ [0006].* The agreed upon actions include a purchase, lease, or sale of a certain product or service. *See ¶ [0016].* In addition, the actions may include visiting a certain sales location, accessing a certain internet site, or answering certain marketing questions. *Id.*

For example, a retail store could provide a small insurance policy to a consumer as a bonus or “gift” in conjunction with a purchase of the retailer’s product or service. *See ¶ [0034].* The policy would then be added to with each additional purchase or other activity the retailer would like to reward the consumer for conducting. *Id.* Thus, *Levison* simply teaches a standard incentive plan arrangement.

In contrast, various embodiments of Claim 1 provide a service contract through ***a first provider*** and insurance coverage through ***a second provider***. Emphasis added. In particular, the service contract protects against mechanical breakdown or other failure of the article of personal property while the additional insurance coverage protects against one or more events such as loss of the article, theft of the article, or other named perils associated with the article.

In light of the above, Applicants respectfully assert that *Becker* and *Levison* fail to teach or suggest a method of providing insurance to a customer, wherein: ***“said service contract is provided by a first provider and said insurance coverage is provided by a second provider, said first and second providers being different entities,”*** as recited by independent Claim 1. Emphasis added. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of independent Claim 1.

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Independent Claim 17

Independent Claim 17 has been rejected under 35 USC § 103(a) as obvious in light of *Becker*, in view of *Levison*. Although Applicants do not agree with the current rejection of Claim 17, in order to facilitate prosecution of the present application, Applicants have amended Claim 17 to further distinguish the claimed invention from the cited prior art. For example, Applicants have amended Claim 17 to specify that “**said service contract and said insurance coverage are provided by two separate providers.**” Emphasis added. Thus, for reasons similar to those explained above in regard to Claim 1, Applicants respectfully assert that *Becker* and *Levison* fail to teach or suggest this feature.

In addition, Applicants respectfully traverse the Examiner’s contention that since a bundled registration and loss protection service and a database that can be updated by a customer and/or a retailer are provided in *Becker*, a property protection program that is referenced by single identification indicia is taught in *Becker*. *Becker* makes no indication on how the information pertaining to the jewelry is stored in the database. *Becker* simply states that a purchase of a gemstone may be registered in a database “such as database 112 which provides a centrally located, repository of information related to gemstones and their owners.” See ¶ [0014]. Furthermore, *Becker* explains that the database can be commercially operated and maintained and provide bundled gemstone registration services and insurance protection options. *Id.* However, *Becker* makes no mention of specific data structure of the information stored in the database. Thus, *Becker* fails to teach or suggest a property protection program that is “**referenced by a single identification indicia,**” as recited by independent Claim 17. Emphasis added.

Accordingly, for the reasons stated above, Applicants respectfully request that the Examiner withdraw the current rejection of this claim.

Dependent Claims 27

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Applicants note that, in various embodiments – such as the embodiment of Claim 27, if the first party stops paying the second provider for the insurance coverage, the service contract through the first provider is unaffected. This is because the two protections are provided through separate independent relationships. Therefore, under these circumstances if the customer experiences a mechanical problem with the article of personal property the customer can still have the article repaired under the service contract though the additional insurance coverage may be void due to lack of payment. Such an advantage is not taught or suggested in *Becker* and *Levison*.

Dependent Claims 2-8, 19-27 and 29

Claims 2-8 depend from independent Claim 1 and therefore include all the limitations of Claim 1 plus additional limitations that further define the invention over the prior art. Claims 19-27 and 29 depend from independent Claim 17 and therefore include all the limitations of Claim 17 plus additional limitations that further define the invention over the prior art. Accordingly, for at least the reasons set forth above in regard to independent Claims 1 and 17, Applicants respectfully assert that these claims are also in condition for allowance.

New Claims

New Claims 31-33

New dependent Claims 31-33 have been added to the application. Support for these claims can be found on Page 3, lines 18-19 and Page 6, lines 9-11.

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CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed November 28, 2007. The foregoing amendments and remarks are believed to have placed the present application in condition for allowance, and such action is respectfully requested. The Examiner is encouraged to contact Applicants' undersigned attorney at (404) 881-7640 or e-mail at chris.haggerty@alston.com to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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